

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Fan et al.

Serial No.: 10/725,378

Group Art Unit: 2129

Filed: December 3, 2003

Examiner: Coughlan, P.

For: SYSTEM AND METHOD FOR SCALABLE COST-SENSITIVE LEARNING

Honorable Commissioner of Patents
Alexandria, Virginia 22313-1450

STATEMENT OF SUBSTANCE OF INTERVIEW

Sir:

In response to the requirement in 37 C.F.R. §1.2, 37 C.F.R. §1.133, and MPEP §713.04, that Applicants provide a statement of the substance of an interview, Applicants hereby submit the following summary.

Applicants gratefully acknowledge Supervisory Patent Examiner Vincent for taking time from his busy schedule to conduct a telephone interview with Applicants' representative on June 1, 2007, for the above-referenced Application.

Concerning the substance of the interview, Applicants' representative asked for clarification of the contents of the Advisory Action mailed on May 30, 2007, since it indicated that a 35 USC §101 rejection would be re-instated if an RCE were to be filed. Applicants' representative suggested that perhaps time could be saved if this issue could be resolved, since, based on his personal experience as an examiner, Examiners typically do not like to write an Examiner's Answer for an Appeal.

The discussion then turned to the issue of inventorship involving two students' names on the IEEE article of record. Applicants' representative indicated that he had filed a new Rule 132 Declaration to cure the earlier declaration considered by the Office as being defective since it failed to use the wording "not by another" and did not include all three co-inventors, but that the

new declaration was incomplete as of the date of the interview because one co-inventor was still unavailable due to illness but would be perfected as soon as possible.

Returning to the issue of the 35 USC § 101 rejection, Applicants' representative then asked whether the specification of the present application provided sufficient practical applications of the invention so as to satisfy the "useful, concrete and tangible result" test of *State Street* and *AT&T*. It was understood by Applicants' representative that SPE Vincent did consider that such practical applications were indeed presented in the specification.

Applicants' representative then asked SPE Vincent the legal basis for the additional requirement mentioned in the Advisory Action that the specification must positively identify all possible uses in order to satisfy the requirement for statutory subject matter. SPE Vincent replied that he was not positive but thought it might be *Benson*. Applicants' representative suggested that this case concerned an algorithm involving conversion between binary and BCD and would not seem applicable.

SPE Vincent then said that he thought perhaps it was *Warmerdam*. Applicants' representative suggested that this case also was not appropriate, since it involved the issue of when data structures could be considered as statutory subject matter in claims.

The discussion terminated at this point, leaving open the question of legal support for the additional requirement of statutory subject matter, as suggested in the Advisory Action. SPE Vincent indicated that he considered that the Board should be involved in the non-statutory subject matter issue.

Respectfully submitted,



Date: June 15, 2007

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